

REMARKS

In the pending Office Action mailed March 16, 2004, Examiner withdrew from consideration claims 11-14 and 28-31 and rejected claims 1-10, 15-27, and 32-38 on the basis of a restriction requirement. In this amendment, Applicants respectfully traverse Examiner's rejection of claims 1-10, 15-27 and respectfully request that Examiner allow the pending claims.

Examiner rejected claims 1-10, 15-27, and 32-38 under 35 U.S.C. § 102(e) on the basis of U.S. Patent 6,631,356 to Van Horn et al. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). Applicants respectfully traverse Examiner's rejection because Van Horn neither expressly nor inherently discloses the subject matter of the rejected claims.

The claimed invention is directed to mechanisms for obtaining seller information in order to facilitate on-line group buying. Using embodiments of the claimed invention, potential sellers can easily and more efficiently provide information about the product, which, for example, can be passed onto potential buyers or used to conduct sales. In independent claim 15, for instance, the role of the seller is expressed through the recitation of a component "configured to receive a seller's description of a featured item to be sold in a first group-buying sale" and a component "configured to receive the seller's instructions for the group-buying sale." Remaining pending independent claims 1, 18, 32-33, 35 and 38, and by extension the claims that depend on these claims, contain similar limitations. In addition, independent claims 1 and 18 further recite, "the seller transmits [] data over the electronic network."

Van Horn does not *expressly* disclose the claimed elements. Van Horn is directed to the formation of an on-line buying group by specifying various parameters. (Abstract) Portions of Van Horn disclose the dropping of a selling price as more offers are made to buy a product. But nowhere does Van Horn expressly disclose a component “configured to receive a seller’s description of a featured item” or a component “configured to receive the seller’s instructions,” as specifically claimed in claim 15. Nor does Van Horn disclose the similar elements found in the other independent claims. Although Van Horn does disclose sales parameters, such as the minimum and maximum quantity to be sold by a co-op (Col. 14), it does not expressly disclose the source from which or how the information is to be obtained – instead leaving these issues open for specific implementations. In the present office action, Examiner claims that claim 1 of Van Horn discloses the receipt of “sale data from the seller that provides the seller’s directions for the first group-buying sale.” (Office Action, p.4) However, the cited portion makes exactly two mentions of “seller” or “sellers” – taking orders “for the featured product upon seller acceptance of received buyer offers” and urging the buyer to make a new irrevocable offer “which the seller may find acceptable” (claim 1) – both of which fall short of the claimed invention. A seller’s hypothetical acceptance of an offer does not disclose a component “configured to receive a seller’s description of a featured item,” as claimed in claim 15; neither does Van Horn expressly cover similar elements in the other independent claims.

Nor does Van Horn *inherently* disclose the claimed elements. “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (BPAI 1990); MPEP 2112. Because Van Horn leaves the source of the sales information

open, the examiner cannot make such a showing. Any sales information disclosed in Van Horn could be sourced from a variety of locations *other* than the seller – the buyer, an intermediary, or a third party, for example. Moreover, this information could be sourced in any of a variety of ways, not necessarily where the seller provides the data over an electronic network, as claimed for instance in independent claims 1 and 18. Accordingly, the claimed elements do not “necessarily flow[]” from Van Horn and are therefore not inherently present in the disclosure. “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). In Van Horn, the sales information may come from a seller, but this is not required by and thus not inherently disclosed in Van Horn’s disclosure.

For at least these reasons, Van Horn does not anticipate the pending claims, expressly or inherently. Applicants respectfully request that Examiner withdraw his rejection of the claims based on this reference. Based on the foregoing, Applicants respectfully request that the rejection based on Van Horn be withdrawn. In addition, Applicants respectfully invite Examiner to contact Applicants’ representative at the number provided below if Examiner believes it will help expedite furtherance of this application.

Respectfully Submitted,
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Date: 8/16/04

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